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1 UNITED STATES PATENT AND TRADEMARK OFFICE
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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

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8 *Ex parte* TOSHIHIKO UENO and YOSHIHIRO HOSHINO
9

10 Appeal 2009-004815
11 Application 09/819,459
12 Technology Center 3600
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16 Decided: December 16, 2009
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20 *Before* MURRIEL E. CRAWFORD, HUBERT C. LORIN, and ANTON W.
21 FETTING, *Administrative Patent Judges*.
22

23 CRAWFORD, *Administrative Patent Judge*.
24
25

26 DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 (2002) from a final rejection of claims 1-28. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

Appellants invented systems and methods for data transfer using a mobile terminal and a two-dimensional barcode, and more particularly, a processing system, server, processing terminal, and communications terminal that can be used to pay for purchases and manage membership cards and admission tickets, and other services (Spec. 1:5-8).

Claim 1 under appeal is further illustrative of the claimed invention as follows:

1. A processing system comprising:

a data management server for storing registration information about a customer, the registration information linked to a financial account of the customer with an external financial institution;

a customer communication terminal adapted for data communication with said data management server and for outputting information for identifying a customer; and

a process execution terminal for receiving said information for identifying the customer from said customer communication terminal and executing a process for said customer, wherein:

said process execution terminal provides said information to said data management server when receiving said information for identifying the customer;

said data management server identifies the customer based on said information provided from said process execution terminal, generates reply information based on said registration information about said customer, the reply information indicating an approval of payment from the financial account, and provides said reply information to said process execution terminal; and

said process execution terminal executes a process for said customer based on said reply information when receiving said reply information;

wherein the information for identifying the customer and the registration information about the customer is associated with each other only at the data management server, the data management server being different than the process execution terminal that receives the information for identifying the customer.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Webb US 6,877,661 B2 Apr. 12, 2005
Webb US 60/225,805 Aug. 16, 2000
(hereinafter “Provisional Application”).

The Examiner rejected claims 1-6, 8, 9, 11-18, 20, 21, and 24-28 under 35 U.S.C. § 102(b) as being anticipated by Webb; and rejected claims 7, 10, 19, 22, and-23 under 35 U.S.C. § 103(a) as being unpatentable over Webb.

ISSUES

Whether “the registration information linked to a financial account of the customer with an external financial institution,” as recited in independent claims 1, 6, 11, 17, 21, and 24-28, is non-functional descriptive material?

Did the Appellants show the Examiner erred in asserting that dependent claims 7, 10, 19, and 22-23 are allowable due to their dependence on one of allowable independent claims 6, 17, and 21?

FINDINGS OF FACT

Specification

Appellants invented systems and methods for data transfer using a mobile terminal and a two-dimensional barcode, and more particularly, a processing system, server, processing terminal, and communications terminal that can be used to pay for purchases and manage membership cards and admission tickets, and other services (Spec. 1:5-8).

Registration information may be, for example, the number of customer's credit card, debit card, or bank account for payment (Spec. 4:13-17).

Registration information may be customer billing information (e.g., amount billed, billing date, details of billing, etc). provided to the data management server from the online shopping, mail order, or utility company (Spec. 6:1-5).

Card information about a card such as a credit card or customer credit card held by a customer is pre-registered in the wallet center along with personal authentication information, portable terminal identification information, and card select information for selecting a particular card (Spec. 13:5-8, 15-18).

The server 30 of the management center has a customer DB (database, data storage) 37 for storing pre-registered customer information. The customer DB 27 contains registration information entered online or by mail by a customer beforehand, including the name and address, and personal information of the customer, telephone numbers of a portable communications terminal 10 held by the customer, the name of the credit institution that the customer wants to use, the number of a card for payment

1 such as a credit card or debit card (hereinafter simply called a “credit card”)
2 of the customer, a bank account number for direct debit and other payment
3 information of the customer. The customer DB 37 also holds status
4 information on the credit card registered by each customer. The status of the
5 credit card registered by the customer is usually “not available” unless
6 access is made by the customer. The status of a credit card selected by the
7 customer and becomes “available” when access is made by the user using a
8 valid password (Spec. 22:8 to 23:1).

10 PRINCIPLES OF LAW

11 *Obviousness*

12 Where the printed matter is not functionally related to the substrate,
13 the printed matter will not distinguish the invention from the prior art in
14 terms of patentability. *In re Gulack*, 703 F.2d 1381, 1385-86 (Fed Cir.
15 1983).

16 During examination, the examiner bears the initial burden of
17 establishing a prima facie case of obviousness. *In re Oetiker*, 977 F.2d
18 1443, 1445 (Fed. Cir. 1992).

19 Once a *prima facie* case of obviousness is established, the burden
20 shifts to Appellant to rebut it. *In re Keller*, 642 F.2d 413, 426 (CCPA 1981).

22 *Claim Construction*

23 During examination of a patent application, a pending claim is given
24 the broadest reasonable construction consistent with the specification and

should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

ANALYSIS

Non-Functional Descriptive

Appellants argue that the coupons savings accounts of the Provisional Application of Webb does not correspond to “the registration information linked to a financial account of the customer with an external financial institution,” as recited in independent claims 1, 6, 11, 17, 21, and 24-28 (App. Br. 9-12). However, even if neither Webb nor the Provisional Application of Webb disclose the aforementioned aspect, it is non-functional descriptive material, and thus cannot distinguish the invention from the prior art in terms of patentability. *See In re Gulack*, 703 F.2d at 1386-86.

Specifically, the aforementioned aspect, when read in view of the Specification, only requires that the registration information include *information* linking the financial account of the customer with the external financial institution. *See In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d at 1364. An actual link, such as a wire-transfer or Internet link, between the registration information and the financial account is not required. Indeed, as set forth in the Specification, the presence of credit card numbers within the registration information is sufficient to “link” the financial account of the customer with the external financial institution.

As the link is merely non-functional descriptive information, it does nothing to alter the underlying operation of either the data management server or the processing system. Accordingly, it cannot distinguish the

1 invention from the prior art in terms of patentability. *See In re Gulack*, 703
2 F.2d at 1386-86.

3 As this rationale for rejecting independent claims 1, 6, 11, 17, 21, and
4 24-28 differ from the rationale set forth by the Examiner, we denominate it a
5 new ground of rejection under 37 C.F.R. § 41.50(b). We also apply this new
6 rationale and new rejection to dependent claims 2-5, 8, 9, 12-16, 18, and 20.

7
8 *Claims 7, 10, 19, 22, and 23*

9 We further apply the new rationale to the obviousness rejection of
10 dependent claims 7, 10, 19 and 22-23 while retaining the Examiner's
11 rationales for rendering the additionally recited aspects of these claims
12 obvious. The Examiner has set forth a proper case of prima facie
13 obviousness with respect to those additional aspects on pages 13-14 of the
14 Examiner's Answer. *See In re Oetiker*, 977 F.2d at 1445. The Appellants
15 have not set forth specific arguments as to why the Examiner erred in
16 rendering obvious those additional aspects¹. Accordingly, as Appellants
17 have not met the burden of rebutting Examiner's prima facie case of
18 obviousness, we decline to overturn these rejections as they apply to the
19 additional aspects set forth in dependent claims 7, 10, 19 and 22-23. *See In*
20 *re Keller*, 642 F.2d at 426.

¹ The entirety of Appellants' argument consists of "the qualified disclosure of Webb does not suggest a modification of Webb in a manner to teach the claimed invention as represented in claims 7, 10, 19 and 22-23" (App. Br. 12).

CONCLUSION OF LAW

On the record before us, Appellants have not shown that the Examiner erred in rejecting claims 1-28.

We enter a new ground of rejection of claims 1-28.

DECISION

The decision of the Examiner to reject claims 1-28 is affirmed.

This decision also contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” This Decision contains a new rejection within the meaning of 37 C.F.R. § 41.50(b) (2007).

37 C.F.R. § 41.50(b) also provides that Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new rejection:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the Examiner, in which event the proceeding will be remanded to the Examiner. . . .

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record.

Should the Appellants elect to prosecute further before the examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the

prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the Appellants elect prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED; 37 C.F.R. § 41.50(b)

hh

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